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09/738,801	12/15/2000	William J. Beyda	00 P 9081 US	2375
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EXAMINER SHELEHEDA, JAMES R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/738,801

**Applicant(s)**

BEYDA, WILLIAM J.

**Examiner**

JAMES SHELEHEDA

**Art Unit**

2424

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/16/10 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 02/18/10 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For example, on page 8, applicant indicates that "pressing a single button to activate the video feature/module causes recording, email creation and insertion into the e-mail". The claims however, are not limited to this. There is no limit to the number of user inputs which can be entered into the system during the video email process. The

only limitation in this regard is during the specific step of attaching the video clip to the email. The claim language is not limited to this type of scenario. As the claims do not clearly define what the different "signals" are, where they originate from, or limit how many may be received, the claims are not limited to what applicant indicates. Language clearly indicating which input signals originate from the user and clarifying that *only* those inputs are received from the user would appear to more clearly limit the claims to the scenario desired by applicant, i.e. "pressing a single button to activate the video feature/module causes recording, email creation and insertion into the e-mail".

Applicant's claim amendments specify that the "activate signal" activates a video email feature which perform the remaining steps. However, in Cleron, the user's first input would be to open the email system (user selection on the main menu to open the email page 110; Fig. 5; column 5, lines 2-35, Fig. 9, steps 200-204). All of the remaining steps occur within this email system and are thus "responsive" to the activate signal, as none of the remaining steps could have occurred until after the email system was activated and opened. This clearly meets the current broad claim limitations.

On page 8, applicant argues that Cleron disclose at two separate user activities required to get from recording to having an email with the recorded video,

In response, it is noted that this the steps recited by Cleron meet the current claim limitations. Cleron discloses one input to start capturing a video clip (column 6, lines 35-48). This input corresponds to the "start clip signal". The second input to "add

to message" will control the system to copy the clip being buffered and attach it to the email (column 6, lines 35-48). This input corresponds to the "end of clip signal". This signal identifies the end of the clip to add it to storage. The system then attaches the clip to the email without requiring any other intervening user input.

As seen in Fig. 7, and described in column 6, lines 9-48, there are only two buttons shown in regards to recording the clip and adding it to the email.

Depression of the first button "freeze" will initiate capture of the video. A second depression of the "freeze" is used to restart the capture process to capture a different clip of the video stream (column 6, lines 9-19).

Once the capture process has begun, depression of the "add to message" button will result in the buffered clip being locally copied and attached to the email (column 6, lines 20-45).

This process clearly meets the claim limitations.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 2 recites "attaching said email video clip compressed in a default compression format and before transmitting, presenting an option for selecting a different compression method" which is not supported by applicant's specification as originally filed. While applicant's specification discloses presenting an option for selecting a compression method *prior* to attaching the email video clip (see Fig. 7; page 8, lines 10-16).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4-7, 10-13, 15-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Cleron et al. (Cleron) (6,223,213) (of record).

As to claim 1, Cleron discloses a method, comprising:

receiving an activate signal activating a video email feature (user selection on the main menu to open the email page 110; Fig. 5; column 5, lines 2-35), the activated video email feature:

sending a start clip signal *responsive* to said activate signal (user selection to begin recording, which cannot occur until after the email page was selected and displayed; Fig. 5 and 7; column 5, lines 2-35, column 6, lines 9-48),

storing streaming video as an e-mail video clip responsive to said start clip signal (capturing video stream; column 6, lines 35-48),

receiving an end of clip a deactivate signal ("add to message signal" ending capture and adding the video to the email; column 6, lines 35-48), and

launching an e-mail message in an e-mail application responsive to said end of clip deactivate signal ("add to message signal" initiating display of an email message with the clip attached; column 6, lines 35-48 and column 7, lines 8-27);

automatically attaching said e-mail video clip at least a portion of said video as an attachment to said e-mail message without user interaction responsive to the end of clip deactivate signal (the "add to message" input will end capture, store and attach the video to the email; column 6, lines 35-48 and column 7, lines 8-27); and

transmitting the e-mail video clip as an attachment to said e-mail message to one or more selected recipient (column 7, lines 47-56).

As to claims 4, 10, 16, 19 and 22, Cleron discloses a telecommunications device, and corresponding method, comprising:

a local area network (Fig. 1; column 1, lines 11-23, column 3, lines 1-24);

a video email system coupled to said local area network (Fig 1), the video email system including:

a video input device for generating video images (column 4, lines 33-40), said video input device including a video control input (column 5, lines 2-35 and column 6, lines 11-13) selectively providing a start video email command signal and an end of clip signal (column 5, lines 2-35 and column 6, lines 11-13), said video input device streaming video images;

a monitor for displaying said video images (see Fig. 2 and 7); and

a Web Access device including an e-mail module (column 3, lines 1-32) and a video control module activated by said start video email command signal, said Web Access device configured to receive streaming video from said video input device responsive to said activated video control module (capturing video stream; column 6, lines 35-48), said email module automatically opening an e-mail message in an e-mail compose window and attaching a video clip of said streaming video without user interaction, to the e-mail message responsive to said activated video control module receiving said end of clip signal (the "add to message" input will end capture, store and attach the video to the email; column 6, lines 35-48 and column 7, lines 8-27), said clip attached to said e-mail message being transmitted to one or more selected recipient (column 7, lines 47-56).

As to claims 5 and 11, Cleron discloses wherein signals from said video control module are provided from responsive to a switch associated with said video input device (column 5, lines 2-10 and column 6, lines 11-13).



As to claims 6 and 12, Cleron discloses wherein said web access device further includes a compression control module selecting a compression format for each transmitted clip attached to an email message (column 6, lines 35-44) and signals from said video control module are provided responsive to a remote controls switch associated with said video input device (column 5, lines 2-10 and column 6, lines 11-13).

As to claims 7 and 13, Cleron discloses wherein signals from said video control module comprise a signal from a button associated with a GUI (Fig. 7; column 6).

As to claim 15, Cleron discloses wherein said web access device comprises a personal computer (column 1, lines 1-29 and column 3, lines 1-24) and further includes a video control module supervising reception and storage of video clips (column 6, lines 9-44), a compression control module selecting a compression format for each transmitted clip attached to an email message (column 6, lines 35-44) and an email module control module activating and controlling emailing (column 6, lines 45-62).

As to claim 17, Cleron discloses wherein at least one recipient is another entity on said LAN (Fig. 1; column 1, lines 11-23, column 3, lines 1-24, column 7, lines 47-56).

As to claim 18, Cleron discloses wherein at least one recipient is an entity external to said LAN (Fig. 1; column 1, lines 11-23, column 3, lines 1-24, column 7, lines 47-56).

As to claim 20, Cleron disclose wherein an end of clip signal is a manual end of clip command (the "add to message" input will end capture, store and attach the video to the email; column 6, lines 35-48 and column 7, lines 8-27).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 8, 9, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleron.

As to claim 2, while Cleron discloses attaching said email video clip compressed in a default compression format (column 6, lines 35-53), he fails to specifically disclose presenting an option for selecting a different compression method.

Nevertheless, the Examiner takes Official Notice that it was notoriously well known in the art at the time the invention was made to allow selection of a compression method. It would have been obvious for one skilled in the art at the time of the invention to modify the system and methods of Cleron by allowing user selected compression

methods in order to allow versatility in storage and transmission formats to ensure proper playback.

As to claims 3, 8, 14 and 21, while Cleron discloses wherein the monitor is a television (column 3, lines 57-67), the claimed "receiving said end of clip signal...responsive to a timeout of a timer" is not taught by Cleron. Nevertheless, the Examiner takes Official Notice that it was notoriously well known in the art at the time of the invention to use a timer as a deactivate signal. It would have been obvious for one skilled in the art at the time of the invention to modify the system and method of Cleron by using a timer deactivate signal in order to simplify user tasks.

As to claim 9, Cleron discloses wherein said web access device comprises a personal computer (column 1, lines 1-29 and column 3, lines 1-24) and further includes a video control module supervising reception and storage of video clips (column 6, lines 9-44), a compression control module selecting a compression format for each transmitted clip attached to an email message (column 6, lines 35-44) and an email module control module activating and controlling emailing (column 6, lines 45-62).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fujii (6,253,231) disclosing a video email system.

Griebenow (7,286,158) disclosing an automated security system which will automatically capture a video clip and attach it to an email.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/  
Primary Examiner, Art Unit 2424

JS